

REMARKS

In the Office Action,¹ the Examiner:

- (1) rejected claims 12, 13, 31, and 45 under 35 U.S.C. § 112;
- (2) rejected claims 1, 3, 5-16, 18, 25, 27, 29-37, and 39-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,424,438 to Vianello (*Vianello*) in view of U.S. Patent Application Publication No. 2005/0086204 (*Coiera*) and U.S. Patent Application Publication No. 2002/0052894 to Bourdoncle et al. (*Bourdoncle*);²
- (3) rejected claim 17 under 35 U.S.C. § 103(a) over *Vianello* in view of *Coiera*, *Bourdoncle*, and U.S. Patent No. 6,636,837 to Nardozi et al. (*Nardozi*); and
- (4) rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Coiera*, *Bourdoncle*, and U.S. Patent No. 7,392,254 to Jenkins (*Jenkins*).

By this Amendment, claim 45 is amended, claim 46 is added, and claims 12, 13, and 31 are canceled without prejudice or disclaimer. Thus, claims 1, 3, 5-11, 14-20, 25, 27, 29, 30, 32-37, and 39-45 are pending in this Application.

1. Rejections Under 35 U.S.C. § 112

The Office Action rejects claims 12, 13, 31, and 45 under 35 U.S.C. § 112.

Claims 12, 31, and 31 are canceled rendering their rejection moot, and claim 45 is

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² The Office Action cites an incorrect publication number when referring to *Bourdoncle*. See, e.g., Office Action at pg. 4.

amended to provide antecedent basis for “facets.” Accordingly, Applicant respectfully requests withdrawal of the rejection of these claims under 35 U.S.C. § 112.

2. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of: (1) claims 1, 3, 5-16, 18, 25, 27, 29-37, and 39-45 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Coiera* and *Bourdoncle*; (2) claim 17 under 35 U.S.C. § 103(a) over *Vianello* in view of *Coiera*, *Bourdoncle*, and *Nardozzi*, and (3) claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Coiera*, *Bourdoncle*, and *Jenkins*. As discussed above, claims 12, 13, and 31 are canceled, rendering their rejection moot.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit and stated that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. § 2141. In comparing the claim to the prior art, three factual inquiries must be addressed: (1) the scope and content of the prior art must be ascertained; (2) the differences between the claimed invention and the prior art must be determined; and (3) the level of ordinary skill in the pertinent art at the time of the invention was made must be evaluated. See *id.*

Independent claim 1 recites, in part, “providing a hit-list of resources having the one or more first attributes; receiving second attributes of the resource through a refinement user interface; *searching the hit-list* for resources having the second

attributes; providing a narrowed hit-list of resources having the first and second attributes; . . . receiving at least one selected resource type through the refinement user interface; [and] *providing a second narrowed hit-list of resources* having the selected resource type from the narrowed hit-list” (emphasis added). Independent claim 25, although of different scope, recites similar elements.

The Office Action alleges that *Vianello* teaches “searching the hit-list” as recited in independent claim 1. See Office Action, pgs. 4-5. Furthermore, while the Office Action acknowledges that *Vianello* fails to teach the claimed “second narrowed hit-list,” paragraphs [0038], [0045], and [0068] of *Bourdoncle* remedy this deficiency. See Office Action, pg. 5. These allegations are incorrect.

First, *Vianello* does not teach the claimed “searching the hit-list” because *Vianello* searches a database, not a hit-list. In particular, *Vianello* notes that employers can use a database 223 to refine their searches for certain skills possessed by talent (i.e., potential employees) who belong to particular associations. See col. 24, lines 34-37. If their search yields more than a predetermined number of results, the system does not provide the results to the employer and instead requests that the employer conduct a new search. See col. 43, lines 1-4. Searching an entire database on multiple occasions does not teach or suggest searching the claimed “hit-list.” Accordingly, *Vianello* fails to teach or suggest “searching the hit-list for resources having the second attributes” as recited in independent claim 1 and similarly recited in independent claim 25.

Second, *Bourdoncle* does not teach or suggest providing the claimed “second narrowed hit-list” because *Bourdoncle* teaches expanding the hit list. In particular, a

user of *Bourdoncle*'s system can conduct a keyword search, and the results of the search can be returned to the user along with the categories in which the results are classified. See paragraphs [0038] and [0067]. When the user selects one of these categories, "the search engine initiates a new search and displays all documents contained in the category" (emphasis added). See paragraph [0067]. Thus, *Bourdoncle* does not teach "providing a narrowed search result having the particular category or type" as alleged by the Examiner. See Office Action, pg. 5. Instead, *Bourdoncle* teaches providing an expanded search result by conducting a new search that displays each and every single document in a particular category. Furthermore, *Bourdoncle*'s results from the narrowed search are not provided "from the narrowed hit-list" as required by the independent claims at least because *Bourdoncle* conducts a new search of the entire database. Providing results of a new search from an entire database is clearly not providing a second narrowed hit-list from the narrowed hit-list. Accordingly, *Bourdoncle* fails to teach or suggest "providing a second narrowed hit-list of resources having the selected resource type from the narrowed hit-list" as recited in independent claim 1 and similarly recited in independent claim 25.

Coiera and *Nardoizzi* fail to remedy these deficiencies at least because these references fail to teach or suggest the above-recited elements of independent claims 1 and 25.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in

view of the prior art. Therefore a *prima facie* case of obviousness has not been established for independent claims 1 and 25. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1 and 25 under 35 U.S.C. § 103.

Furthermore, Applicant respectfully requests withdrawal of the rejections of claims 3, 5-20, 27, 29-37, and 39-45 at least based on their dependence on one of allowable claims 1 or 25, as well as for the additional elements they recite. For example, claim 42 recites "storing a narrowed collection of resources by selecting a subset of the narrowed hit-list." None of the applied references teaches or suggests this element at least because they do not select a subset of a narrowed hit-list. Accordingly, Applicant respectfully requests withdrawal of the rejection of dependent claims 3, 5-20, 27, 29-37, and 39-45 under 35 U.S.C. § 103.

3. New Claim

New claims 46 is allowable over the applied art at least based on its dependence on allowable claim 1, as well as for the element it recites.

4. Conclusion

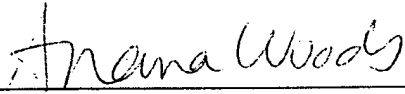
In view of the foregoing, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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